

II. REMARKS

A fourth non-final Office Action was issued in this application on March 19, 2009 (hereinafter "Fourth Non-final Action"). The Fourth Non-final Action and the references cited therein have been carefully reviewed; this submission is believed to be fully responsive to the Fourth Non-final Action. Claims 1-5, 7-16, 25-27, 30, 31, 33 and 34 are pending in this application; all pending claims currently stand rejected. Claim 25 is amended herein merely to provide proper antecedent basis. As such, there are no substantive amendments to the claims, drawings, or specification presented herein. After entering this response, claims 1-5, 7-16, 25-27, 30, 31, 33 and 34 remain pending.

A. CLAIM REJECTIONS – 35 U.S.C. 112

1. 35 U.S.C. 112, first paragraph

Claims 26 and 27 are rejected under 35 U.S.C. § 112, first paragraph, for failing to comply with the written description requirement. These rejections are traversed once again for failing to comport with Federal Judicial mandates and MPEP directives.

The objective standard for determining compliance with the § 112, first paragraph, written description requirement, as established by judicial precedent and codified by MPEP guidelines, is whether an applicant's description "allow[s] persons of ordinary skill in the art to recognize that he or she invented what is claimed." MPEP 2163.02, citing In re Gosteli, 872 F.2d 1008, 1012 (Fed. Cir. 1989). Each claim need not encapsulate every possible permutation of the invention to meet 112 requirements. Rather, all that is necessary to satisfy the written description requirement is to show that one was "in possession" of the claimed invention "as of the filing date sought". Id. See also, Vas-Cath Inc. v. Mahurkar, 935 F.2d 1555, 1563-64, (Fed. Cir. 1991).

To show "possession", and thus compliance with the written description requirement, does not demand claim language be repeated verbatim in the detailed description portion of the specification. See MPEP 2163.02 ("The subject matter of the claim need not be described literally (i.e., using the same terms or *in haec verba*) in order for the disclosure to satisfy the description requirement." Emphasis in original.) Rather, one complies with 112, ¶1, written description "by such descriptive means as words, structures, figures, diagrams, formulas, etc.,

that fully set forth the claimed invention.” Lockwood v. American Airlines, Inc., 107 F.3d 1565, 1572, (Fed. Cir. 1997). Notably, “possession” may be evidenced by a “showing that the invention was ‘ready for patenting’ such as by the disclosure of drawings ... that show that the invention was complete.” MPEP 2163. The pending 112, ¶1, rejections do not properly substantiate, under MPEP and Federal Judicial requirements, that Applicants’ specification does not comply with the written description requirement.

With respect to claim 26, the Examiner finds that the claim “contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.” Fourth Non-final Action, at 2, ¶2. In particular, the Examiner opines “it was not specified that the door [sic] was “only” moved “subsequent to the opening of the door of the housing”. Id. The Examiner then erroneously observes, without any evidentiary support, that “[t]here may be other causes of the movement such as tipping the apparatus.” Id.

The subject specification conveys with reasonable clarity that, as of the filing date, Applicants were in possession of the invention presented in claim 26. For instance, paragraph [0038] of Applicants’ specification explains that “a door 321 prevents unauthorized access to the coin bags 309”, and that “[a]t certain times or upon the occurrence of certain events ... an operator accesses the coin bags 309” wherein “the operator opens the door 321 and moves the coin receptacle station 304 from an operating position.” In another example, paragraph [0042] of the specification recites that “rotatable bag station 404 permits an operator to access each of the coin bags 406 from the front of the coin processing device 400 *after opening a door 413.*” (Emphasis added). Likewise, Applicant’s specification explains that “[i]n operation, *an operator of the coin processing device 500 that desires to access the coin receptacles first opens a front door 520 of the housing 503 to access the coin receptacles.*” Id., ¶ [0051] (Emphasis added). Even Applicants’ originally presented claims disclose “a door moveable between an open position and a closed position, *the door permitting a moveable platform to move from the first position to the second position when the door is in the open position.*” (Emphasis added). Claim 14. This disclosure shows that the specification conveys, with reasonable clarity that, as of the filing date sought, Applicants were in possession of the invention recited in claim 26.

The Examiner’s allegations do not establish why a person of ordinary skill in the art would not recognize in Applicants’ disclosure a method comprising the acts of “opening a door

of the housing prior to moving any coin receptacle platform” and “moving, only subsequent to the opening of the door of the housing, a coin receptacle platform from the first position to the second position.” According to MPEP 2163.04, Applicants’ specification “is presumed to be adequate, unless or until sufficient evidence or reasoning to the contrary has been presented by the examiner to rebut the presumption.” Emphasis added. The possibility that “[t]here may be other causes of the movement such as tipping the apparatus”, as proffered by the Examiner, is irrelevant and has no bearing on whether the subject specification complies with 112, ¶1. Absent evidence to the contrary, the pending rejection of claim 26 under 112, ¶1, must be withdrawn, such action toward that end being respectfully requested.

Turning then to claim 27, the Examiner alleges that the original disclosure does not specify that Applicants’ claimed platform is “‘only’ moved ‘from the first operable position to said second inoperable position [and back]’.” Fourth Non-final Action, at 2, ¶3. This observation appears to be premised on the unfounded and otherwise self-serving observation that “[t]here may be other causes of the movement such as finite movement between the first and second operable positions.” Id.

The subject specification conveys with reasonable clarity that, as of the filing date, Applicants were in possession of the invention presented in claim 27. By way of example, Applicants’ Abstract explains that “[e]ach moveable platform is moveable between a first position and a second position” wherein “[e]ach moveable platform is disposed entirely within the housing for receiving coins . . . when in the first position” and wherein “each moveable platform extends out of the housing when in the second position.” (emphasis added). Original FIGS. 1, 4a-5a and 7-9 also provide adequate support for the objected to claim language. See MPEP 2163(II)(A)(3)(a) (“Possession may [] be shown by a clear depiction of the invention in detailed drawings . . . which permit a person skilled in the art to clearly recognize that applicant had possession of the claimed invention.”) See also, Mahurkar, 935 F.2d at 1565, (“drawings alone may provide a ‘written description’ of an invention as required by Sec. 112”).

The Examiner’s allegations do not establish why a person of ordinary skill in the art would not recognize in Applicants’ disclosure a coin processing device that includes “[a] plurality of individually moveable platforms [] connected to a respective one of [a] plurality of tracks and being physically constrained to slide only from said first operable position to said second inoperable position and from said second inoperable position to said first operable

position along a corresponding one of said plurality of tracks.” Once again, Applicants’ specification “is presumed to be adequate” absent sufficient evidence to the contrary. MPEP 2163.04. The mere prospect that “[t]here may be other causes of the movement such as finite movement between the first and second operable positions”, as proposed by the Examiner, is irrelevant and has no bearing on whether the subject specification complies with 112, ¶1. Absent evidence to the contrary, the pending rejection of claim 27 under 112, ¶1, must be withdrawn, such action being respectfully requested.

2. 35 U.S.C. 112, second paragraph

Claims 26 and 27 are once again rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regards as their invention. With respect to claim 26, the Examiner alleges that “it is unclear if there are or not other mechanisms for opening the door”. Fourth Non-final Action, at 3, ¶3. Likewise, as to claim 27, the Examiner states that “it is unclear if there are other movements of the platforms along the tracks.” *Id.*, ¶4. The § 112, ¶2, rejections of claims 26 and 27 are traversed for failing to comport with Federal Judicial mandates and MPEP directives.

The test for definiteness under § 112, second paragraph, is whether “those skilled in the art would understand what is claimed when the claim is read in light of the specification.” Orthokinetics, Inc. v. Safety Travel Chairs, Inc., 806 F.2d 1565, 1576 (Fed. Cir. 1986). As explicated in related judicial opinions and MPEP guidelines:

[t]he essential inquiry pertaining to [the section 112 definiteness] requirement is whether the claims set out and circumscribe a particular subject matter with a reasonable degree of clarity and particularity. Definiteness of claim language must be analyzed, not in a vacuum, but in light of:

- (A) The content of the particular application disclosure;
- (B) The teachings of the prior art; and
- (C) The claim interpretation that would be given by one possessing the ordinary level of skill in the pertinent art at the time the invention was made.

MPEP 2173.02. See Metabolite Labs., Inc. v. Lab. Corp. of Am. Holdings, 370 F.3d 1354, 1366-67 (Fed. Cir. 2004). It is not relevant to 112, ¶2, inquiries whether alternate embodiments could be incorporated into the claim under scrutiny. In fact, “if the language used by applicant satisfies the statutory requirements of 35 U.S.C. 112, second paragraph, but the examiner merely wants

the applicant to improve the clarity or precision of the language used, the claim must not be rejected under 35 U.S.C. 112, second paragraph”. MPEP 2173.02 (emphasis added.)

Claim 26 recites “opening a door of the housing”. The Examiner appears to be proposing that one of ordinary skill, in view of Applicants’ specification and common knowledge in the art, would not know how to open the door 321 of the housing 302 (e.g., FIG. 4a). Claim 26 has not been shown to be indefinite. Even if there are “other mechanisms for opening the door”, as proposed by the Examiner, such an inquiry is not relevant in a discussion of definiteness. “The examiner's focus during examination of claims for compliance with the requirement for definiteness of 35 U.S.C. 112, second paragraph, is whether the claim meets the threshold requirements of clarity and precision, not whether more suitable language or modes of expression are available.” MPEP 2173.02.

Likewise, as to claim 27, the invention presented therein comprises, *inter alia*:

a plurality of tracks, each of the plurality of individually moveable platforms being connected to a respective one of the plurality of tracks and being physically constrained to slide only from said first operable position to said second inoperable position and from said second inoperable position to said first operable position along a corresponding one of said plurality of tracks.

The claim positively recites that the moveable platforms are “physically constrained to slide . . . along a corresponding one of said plurality of tracks”. A person of ordinary skill, looking at FIGS. 6-9 and evaluating the corresponding sections of the spec, would readily appreciate Applicants’ “possession” of such subject matter at the time of filing. For the 112, ¶2, rejection to be proper, the Examiner must demonstrate that one of ordinary skill in the art, having read claim 27 in light of the specification, would fail to appreciate the subject matter set forth in the claim with a reasonable degree of clarity. See e.g., Solomon v. Kimberly-Clark Corp., 216 F.3d 1372, 1379 (Fed. Cir. 2000). Absent such a showing, the rejection must be withdrawn. See In re Larsen, No. 01-1092 (Fed. Cir. May 9, 2001).

B. CLAIM REJECTIONS – 35 U.S.C. 103

1. Claims 1-2 and 4

Claims 1, 2 and 4 are rejected under 35 U.S.C. § 103(a) as being unpatentable over U.S. Patent Appl. Publ. No. 2002/0162724 A1, to Hino et al. (hereinafter “Hino”), in view of U.S.

Patent Appl. Publ. No. 2001/0008358 A1, to Brustle (hereinafter “Brustle”). Applicants respectfully traverse this rejection as deficient and improper.

A proper rejection under Section 103(a) of the U.S. Patent Act (i.e., Title 35 of the U.S. Code) requires the examiner establish *prima facie* obviousness. In particular, the legal concept of *prima facie* obviousness is a procedural tool of examination which applies to all arts, allocating who has the burden of going forward with production of evidence in each step of the examination process. See MPEP 2142. See also, In re Rinehart, 531 F.2d 1048 (CCPA 1976); In re Linter, 458 F.2d 1013 (CCPA 1972). Of notable importance, it is “[t]he examiner [who] bears the initial burden of factually supporting any *prima facie* conclusion of obviousness.” MPEP § 2142 (emphasis in original). See In re Oetiker, 977 F.2d 1443, 1445 (Fed. Cir. 1992). In fact, “[i]f the examiner fails to produce a *prima facie* case, the applicant is under no obligation to submit evidence of nonobviousness.” MPEP § 2142. See In re Piasecki, 745 F.2d 1468, 1471 (Fed. Cir. 1984) (emphasis in original).

Similar to establishing an anticipation rejection under Section 102 of the Patent Act, to properly substantiate a *prima facie* case of obviousness under Section 103(a) requires the prior art teach each and every element and limitation of the rejected claim(s). See In re Kotzab, 217 F.3d 1365, 1369-71 (Fed. Cir. 2000); In re Royka, 490 F.2d 981 (CCPA 1974) (“[O]bviousness requires a suggestion of all limitations in a claim.”) In setting forth a *prima facie* case, the examiner may not opportunistically disregard certain claim language; rather, “[e]very word in a claim must be considered in judging the patentability of a claim against the prior art.” In re Wilson, 424 F.2d 1382, 1385 (CCPA 1970). See also, In re Ochiai, 71 F.3d 1565, 1572 (Fed. Cir. 1995) (“When determining whether a claim is obvious, an examiner must make ‘a searching comparison of the claimed invention – including all its limitations – with the teaching of the prior art.’”) Moreover, the reviewing examiner must provide a clear articulation, on the record, where each element and limitation of the rejected claim can be found in the prior art. See In re Rijckaert, 9 F.3d 1531, 1533 (Fed. Cir. 1993); In re Yates, 663 F.2d 1054, (C.C.P.A 1981)

“The key to supporting any rejection under 35 U.S.C. 103 is the clear articulation of the reason(s) why the claimed invention would have been obvious.” MPEP 2143. According to the U.S. Supreme Court, “rejections on obviousness grounds cannot be sustained by mere conclusory statements; instead, there must be some articulated reasoning with some rational underpinning to support the legal conclusion of obviousness.” KSR International Co. v. Teleflex

Inc., 127 S. Ct. 1727, 1741 (2007), citing In re Kahn, 441 F. 3d 977, 988 (CA Fed. 2006) (emphasis added). The Supreme Court goes on to clarify that there must be “an apparent reason to combine the known elements in the fashion claimed by the patent at issue”; such reasoning must “be made explicit.” Id.

Section 2143.01(VI) of the MPEP notes that the Examiner’s proposed modification of a cited reference is not sufficient to render a claim *prima facie* obvious “[i]f the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified”. Citing In re Ratti, 270 F.2d 810 (CCPA 1959). The court in Ratti emphasizes that a proposed modification which requires a “redesign of the elements shown in [the primary reference]” is grounds for overturning a finding of obviousness. See MPEP § 2143.01(VI). See also, Ex parte Lovett, 2007-1451 (BPAI June 13, 2007) (“[A] combination of references that would require a substantial reconstruction and redesign of the elements shown [in] the prior art as well as a change in the basic principles under which the prior art was designed to operate is not a proper ground for an obviousness rejection”) The Examiner has not made a *prima facie* showing of obviousness in accordance with Federal Regulations and Judicial precedent.

The Examiner rejects claims 1, 2 and 4 on the premise that Hino discloses every element and limitation of claim 1, except for “a dampening mechanism configured to exert a damping force on the coin receptacle station during movement of the coin receptacle from the first position to the second position and from the second position to the first position.” See Fourth Non-final Action, at 4, ¶1. In light of the identified deficiency of the Hino reference, the Examiner turns to Brustle, finding that:

Brustle shows a similar device having a dampening mechanism (Fig. 6, 20) and first & second ends (7 & 8) for the purpose of disposing the dampening mechanism and the coin receptacle station can be set [sic] into the housing (paragraph [0003]). Therefore, it would have been obvious to a person having ordinary skill in the art at the time the [sic] invention to modify Hino as taught by Brustle and include Brustle’s similar device having a dampening mechanism and first & second ends for the purpose of disposing the dampening mechanism and the coin receptacle station can be set [sic] into the housing.

Id., ¶2 (emphasis added). The pending 103 rejection of independent claims 1, 2 and 4, is improper for not clearly articulating the grounds for rejection and failing to provide a proper “apparent reason” to make the Examiner’s proposed modification.

The pending 103(a) rejection of claim 1 is flawed for a number of reasons. In one instance, the Examiner's classification of Brustle's disclosed furniture 1 and drawers 2 (see reference FIG. 1) as "a similar device" to Applicants' claimed coin processing device, which is shown in various exemplary embodiments in FIGS. 1, 4a, 5a, and 6, is self-serving and clearly unsupported by the reference. Such mischaracterization of Brustle is evidenced by the Examiner's misleading statement that Brustle discloses "disposing [a] dampening mechanism and [a] coin receptacle station ... into [a] housing", Fourth Non-final Action, at 4, when in fact Brustle does not depict, describe, or in any way disclose a coin receptacle station. Likewise, the Examiner's indication that Brustle's damper housing 7 can be considered a "first end" and Brustle's slider rack 8 can be considered a "second end" is clearly erroneous.

In addition to the above deficiencies, the pending 103(a) rejection of claim 1 is also improper because the Examiner has not provided an "apparent reason" why a person of ordinary skill would be compelled to modify Hino in light of the teachings of Brustle. The only ostensible motivation to combine Hino with Brustle is to ... combine Hino with Brustle – i.e., "for the purpose of disposing the dampening mechanism and the coin receptacle station can be set [sic] into the housing." *Id.* The Examiner's failure to provide any actual motivation or reason to combine the cited prior art is grounds alone to render the entire 103(a) rejection improper.

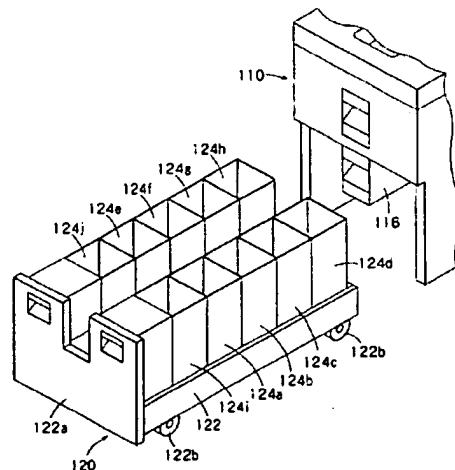
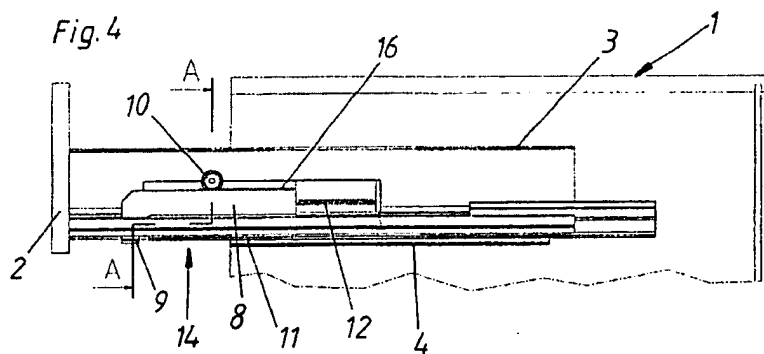


FIG. 4

Irrespective of the complete lack of a proper motivation or reason to combine Hino and Brustle, any such combination would require a "reconstruction and redesign of the elements shown in [the Hino reference] as well as a change in the basic principle under which [Hino's storage unit 120] was designed to operate." *In re Ratti*, 270 F.2d at 813. Hino explicitly states that "[a]s

obvious from FIGS. 3 and 4, the storage unit 120 and the return box 116 are independent of each other". Hino, ¶[0136] (emphasis added). See also, Hino FIG. 4 (recreated above). However, if one were to integrate Brustle's "Pull-out Guidance Assembly for Drawers", seen in reference FIG. 4 (recreated below), including housing 7 fixed to Hino's processing device housing 110, sliding carrier 8 fastened to Hino's storage unit 120, slider stop 9, pinion 10, body-side stop 11, tension spring 12, and rotation damper 20, would require redesigning Hino's storage unit 120 to be continuously attached and fixed to the coin processing unit 110. As such, there would be no motivation to make the Examiner's proposed modification of Hino in light of Brustle.



For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejection of claims 1, 2 and 4 as obvious over Hino and Brustle is improper and should therefore be withdrawn.

2. Claim 3

Claim 3 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino and presumably Brustle, and further in view of commonly owned U.S. Patent No. 6,318,537 B1, to Jones et al. (hereinafter "Jones"). Applicants submit that claim 3 is patentably distinguishable from the prior art of record for at least those reasons as independent claim 1, see supra § II.B.1, at 12-15, from which it ultimately depends. According to MPEP 2143.03, "[i]f an independent claim is nonobvious under 35 U.S.C. 103, then any claim depending therefrom is [also] nonobvious." Citing In re Fine, 837 F.2d 1071 (Fed. Cir. 1988). The Examiner's proposed modification of Hino in light of the teachings of Jones does not cure the fact that Hino fails to disclose all of the elements and limitations of independent claim 1. Accordingly, the pending § 103(a) rejection of claim 3 is improper, and should therefore be withdrawn.

3. Claims 5, 7-9, 27, 33 and 34

Claims 5, 7-9, 27, 33 and 34 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino, in view of U.S. Patent No. 4,387,942, to Lense (hereinafter “Lense”). Applicants respectfully traverse this rejection as deficient and improper.

Independent claims 5 and 27 are rejected on the grounds that Hino discloses every element and limitation respectively presented in claims 5 and 27, except for:

1. Claim 5 – “a track along which each moveable platform slides when moving from the first position to the second position and from the second position to the first position, wherein each of the moveable platforms is at least substantially centered directly over a corresponding track”; and
2. Claim 27 – “a plurality of tracks, each of the plurality of individually moveable platforms being connected to a respective one of the plurality of tracks and being physically constrained to slide only from said first operable position to said second inoperable position and from said second inoperable position to said first operable position along a corresponding one of said plurality of tracks”

See Fourth Non-final Action, at 5, ¶¶4, 6, ¶¶1-2. In light of the deficiencies of Hino, the Examiner attempts to supplement those limitations omitted therefrom by cross-referencing Lense, finding that:

Lense shows a similar device having a track (see Fig. 3, 26; Note: the overall track profile is a rectangle) for the purpose of supporting a platform to slide in a coin receptacle station in the housing (column 1, lines 5-7). Therefore, it would have been obvious to a person having ordinary skill in the art at the time [sic] the invention to modify Hino as taught by Lense and include Lenses [sic] similar device having a track for the purpose of supporting a platform to slide in a coin receptacle station in the housing.

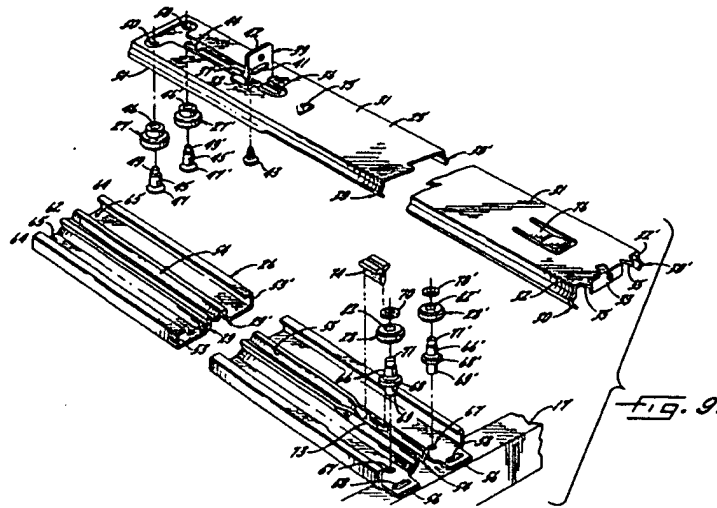
Id., at 6, ¶4 (emphasis added). The pending 103(a) rejection of independent claims 5 and 27, and thus any claims respectively depending therefrom, is improper for not clearly articulating the grounds for rejection and failing to provide an “apparent reason” to make the Examiner’s proposed modification.

Similar to the § 103(a) rejection of base claim 1, the pending rejection of independent claims 5 and 27 is flawed for a variety of reasons. By way of example, the Examiner’s suggestion that Lense’s disclosed cabinet 13 and drawers 11 (see reference FIG. 1) is “a similar device” to Applicants’ claimed coin processing device (see FIGS. 1, 4a, 5a, and 6) is self-serving and uncorroborated by the reference. Such mischaracterization of Lense is verified by the Examiner’s misleading statement that Lense discloses “a platform to slide in a coin receptacle

station in [a] housing (column 1, lines 5-7)", Fourth Non-final Action, at 6, when in fact Lense does not depict, describe, or in any way disclose a coin receptacle. Likewise, the Examiner wholly fails to indicate where in Hino and/or Lense the prior art discloses "[a] plurality of individually moveable platforms [each] being connected to a respective one of the plurality of tracks and being physically constrained to slide only from said first operable position to said second inoperable position and [back]".

On top of the aforementioned deficiencies, the § 103(a) rejection of claims 5 and 25 is also improper because the Examiner has not provided a proper motivation or an "apparent reason" why a person of ordinary skill would be inspired to modify Hino in light of the teachings of Lense. The only perceived reason provided by the Examiner to modify Hino in view of Lense is "for the purpose of supporting a platform to slide in a coin receptacle station in the housing." Fourth Non-final Action, at 6. However, Hino's wheeled drawer 122 is already sufficiently supported by casters 122b, and therefore does not require additional structure for "supporting a platform to slide in a coin receptacle station in [a] housing", as proposed by the Examiner. The Examiner's failure to provide any actual motivation or reason to combine the cited prior art is grounds alone to render the entire 103(a) rejection improper.

Regardless of the Examiner's failure to present a proper motivation to combine Hino and Lense, as required by the MPEP and corresponding judicial precedent, any such combination would require a substantial "reconstruction and redesign" of the elements shown in Hino, as well as "a change in the basic principle under which [Hino's storage unit 120] was designed to operate." In re Ratti, 270 F.2d at 813. The discussion above with respect to the proposed modification of Hino in light of Brustle, supra § II.B.1, at 14-15, is equally relevant here, and therefore is incorporated by reference. In particular, if one were to assimilate Lense's "Drawer Slide Assembly", seen in reference FIG. 9 (recreated below), including upper and lower elongated members 25 and 26 each fastened to a respective one of Hino's processing device housing 110 and storage unit 120, journaled rollers 27, 27', 28 and 28', clip 39, tab 33, bracket 59, and the numerous other disclosed parts, would require redesigning Hino's storage unit 120 to be continuously attached and fixed to the coin processing unit 110. As such, there would be no motivation to make the Examiner's proposed modification of Hino in light of Lense.



For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejection of base claims 5 and 27, as well as claims 7-9 and 33-34 which respectively depend therefrom, as obvious over Hino and Lense is improper and should therefore be withdrawn.

4. Claim 25

Claim 25 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino, in view of Lense. Claim 25 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino, in view of U.S. Patent No. 4,450,968, to Muellner (hereinafter "Muellner"). Applicants traverse both these rejections as insufficient and improper.

The Examiner rejects claim 25 under § 103(a), finding that Hino discloses, *inter alia*, "determining, using a controller (U', FIG. 42), if a predetermined number of coins (paragraph [0042], the number can be all the coins) have been discharged to a coin receptacle", and thereafter "automatically terminating coin sorting when said controller determines that a predetermined number of coins have been discharged to said coin receptacle (U'; terminate when all coins have been sorted)". Fourth Non-final Action, at 7, ¶¶ 4-5, 9, ¶¶ 6-7 (emphasis added). The Examiner thereafter acknowledges that Hino does not disclose "a track on which the platform is centered." *Id.*, ¶ 9.

In light of Hino's failure to disclose all of claim 25's limitations, the Examiner turns once again to Lense, finding that "Lense shows a similar device having a track (see Fig. 3, 26) for the purpose of supporting a platform to slide in the housing (column 1, lines 5-7)." *Id.*, at 7. Based

solely on this observation, the Examiner proposes that “it would have been obvious to a person having ordinary skill in the art at the time [sic] the invention to modify Hino as taught by Lense and include Lense’s similar device having a track for the purpose of supporting a platform to slide in the housing.” *Id.*, at 7-8. In the alternative, the Examiner cites Muellner for purportedly teaching “a similar device having a track ... for the purpose of receiving and capturing the casters (column 2, lines 57-66),” and therefore proposes that “it would have been obvious ... to modify Hino as taught by Muellner and include Muellner’s similar device having a track for the purpose of receiving and capturing the casters.” *Id.*, at 9, ¶2. The prior art of record, namely the Hino and Lense references, is insufficient to render Applicants’ claim 25 *prima facie* obvious.

Hino, Lense and/or Muellner, whether considered singly or in aggregate, have not been shown to teach each and every limitation of claim 25. In particular, neither Lense nor Muellner are directed toward a coin processing device of any manner or kind, and therefore cannot disclose the above-highlighted limitations. Likewise, Hino does not illustrate or discuss “determining ... if a predetermined number of coins have been discharged to one of the coin receptacles” and, in response to the controller “determin[ing] that a predetermined number of coins have been discharged to said one coin receptacle”, the system “automatically terminating coin sorting”. The Examiner claims that Applicants’ claimed act of “determining” is disclosed in paragraph [0042] of Hino; the cited section of Hino provides no such disclosure. In contrast, paragraph [0042] is directed solely to the manner by which Hino’s coin sorting apparatus sorts coins of different diameter. Applicants have reviewed the Hino reference, and were unable to locate any disclosure of Hino actively “determining ... if a predetermined number of coins have been discharged”, and responsively “terminating coin sorting” upon determining that the predetermined number of coins has in fact been discharged.

In addition to Hino, Lense and Muellner failing to disclose each and every limitation of claim 25, the Examiner has not provided a proper motivation or an “apparent reason” why a person of ordinary skill would be inspired to modify Hino in light of the teachings of Lense or Muellner. For example, with regard to the former, any such combination of Hino and Lense would require a substantial “reconstruction and redesign” of the elements shown in Hino, as well as “a change in the basic principle” under which Hino’s storage unit 120 was designed to operate. The discussion above with respect to the proposed combination of Hino and Lense as it pertains to base claims 5 and 27, *supra* § II.B.3, at 16-17, is equally relevant here, and therefore

is incorporated by reference. In a similar respect, with regard to the latter, modifying Hino in light of Muellner, as proposed by the Examiner, would require a “reconstruction and redesign” of Hino’s storage unit 120 – e.g., redesigning the unit 120 and casters 122b to be received in and mate with Muellner’s Nestable Cart Anti-reverseing Apparatus. As such, there would be no motivation to make the Examiner’s proposed modification of Hino in light of Lense.

For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejections of base claim 25 as obvious over Hino and Lense or Hino and Muellner are improper and should therefore be withdrawn.

5. Claims 27 and 33

Claims 27 and 33 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner. Applicants respectfully traverse this rejection as insufficient and improper.

Muellner shows a shopping cart return rack having a channel 24 into which an outwardly projecting wheel 42 of a shopping cart 14 may enter from one side and exit from an opposing side, but is otherwise restricted from reverse travel from the exit end towards the entrance end. See Muellner Abstract; Col. 5, ll. 1-16. The Examiner asserts that Muellner shows a “similar device” having a track, indicated as portion T1 of FIG. G1 on page 10 of the Fourth Non-final Action, “for the purpose of receiving and capturing casters”. Id. The Examiner alleges that “it would have been obvious ... to modify Hino as taught by Muellner and include Muellner’s similar device having a track for the purpose of receiving and capturing the casters.” Fourth Non-final Action, at 10, ¶2. The Examiner’s interpretation of Muellner is erroneous and incomplete, rendering the corresponding rejection of claim 27 insufficient.

The combination of Hino and Muellner does not teach, suggest, or otherwise disclose each and every limitation of claim 27. For instance, neither Hino nor Muellner discloses, *inter alia*, “a plurality of individually moveable platforms each having at least one coin receptacle disposed thereon”. In addition, Hino and Mueller, individually and collectively, fail to disclose a “a plurality of tracks” or, for that matter, even a single track whereat each of the individually moveable platforms is “connected to a respective one of the plurality of tracks and [is] physically constrained to slide only from said first operable position to said second inoperable position and

from said second inoperable position to said first operable position along a corresponding one of said plurality of tracks". (Emphasis added.)

The Examiner again argues, in reliance upon MPEP § 2144.04(VI)(B) and In re Harza, 274 F.2d 669 (CCPA 1960), that Applicants' claimed "plurality of individually moveable platforms" is "a mere duplication" of the single, moveable cart 120 disclosed in Hino, and therefore, would have been obvious to one of ordinary skill in the art. The court in In re Harza stated that "[i]t is well settled that the mere duplication of parts has no patentable significance unless a new and unexpected result is produced, and we are of the opinion that such is not the case here." Id. Although this is not a *per se* rule, the Examiner impermissibly treats it as such. To date, the Examiner has not set forth any evidentiary basis upon which this conclusion may be legitimately founded. Utilization of multiple, individually-movable platforms in the manner disclosed by Applicants does function differently than a single, movable drawer, such as is provided in Hino. By way of example, the claimed "plurality of individually moveable platforms" serves to facilitate access to the coin receptacles contained within a coin processing machine and, depending on which coin receptacle(s) the operator needs to empty, the operator is enabled to slide out one of the moveable platforms 504 at a time (see, e.g., FIG. 6) to access coins contained in the coin receptacle(s) of interest (see, e.g., par. [0051]). In clear contradistinction, for the same operator to access many of Hino's coin sorting cassettes 124a-124i requires the entire cart 120 be moved.

As stated by the Federal Circuit in In re Ochiai, "reliance on *per se* rules of obviousness is legally incorrect and must cease." 71 F.3d 1565, 1572 (Fed. Cir. 1995). For a *prima facie* case of obviousness to be established, the teachings from the prior art itself must appear to have suggested the claimed subject matter to one of ordinary skill in the art. See In re Rinehart, 531 F.2d 1048, 1051 (CCPA 1976). The possibility that the prior art "could be" modified is not sufficient to establish a *prima facie* case of obviousness. See In re Fritch, 972 F.2d 1260, 1266 (Fed. Cir. 1992). By Federal Judicial precedent, the Examiner therefore must, and has still failed to, explain why the prior art would have suggested to one of ordinary skill in the art the desirability of the asserted modification. See Id., 972 F.2d at 1266.

Hino and Muellner also fail to disclose platforms that "slide" between "said first operable position to said second inoperable position". The Examiner cites FIG. 4 of Hino, alleging that "122 slides into the compartment of 110". Such a construction is not "reasonable". The

“broadest reasonable interpretation” of the claims permitted by law must be consistent with “the interpretation that those skilled in the art would reach.” In re Cortright, 165 F.3d 1353, 1359 (Fed. Cir. 1999). In this vein, “[c]laims are not to be read in a vacuum, and limitations therein are to be interpreted in light of the specification in giving them their ‘broadest reasonable interpretation’.” In re Marosi, 710 F.2d 799, 802, 218 USPQ 289, 292 (Fed. Cir. 1983). The Federal Circuit’s *en banc* decision in Phillips v. AWH Corp. expressly defined the “broadest reasonable interpretation” standard, stating that:

The Patent and Trademark Office (“PTO”) determines the scope of claims in patent applications not solely on the basis of the claim language, but upon giving claims their broadest reasonable construction “in light of the specification as it would be interpreted by one of ordinary skill in the art.” In re Am. Acad. of Sci. Tech. Ctr., 367 F.3d 1359, 1364[, 70 USPQ2d 1827] (Fed. Cir. 2004). Indeed, the rules of the PTO require that application claims must “conform to the invention as set forth in the remainder of the specification and the terms and phrases used in the claims must find clear support or antecedent basis in the description so that the meaning of the terms in the claims may be ascertainable by reference to the description.” 37 CFR 1.75(d)(1).

415 F.3d 1303 (Fed. Cir. 2005). See also, In re Hyatt, 211 F.3d 1367, 1372 (Fed. Cir. 2000). Claims must be read in view of the specification, of which they are a part. The Examiner in the present case improperly interprets the term “slide” to include a generalized movement of drawer 122 supported by casters 122b. The Examiner thus completely disregards the context of the recited terminology as it is used in the specification and as it would be reasonably interpreted by one of ordinary skill in the art. To wit, Hino’s drawer 122 does not “slide” into the compartment 110. When it is pushed, the casters roll, and the drawer 122 rolls into the compartment.

For at least the foregoing reasons, the pending 35 U.S.C. § 103(a) rejection of claims 27 and 33 as obvious over Hino and Muellner are improper and should therefore be withdrawn.

6. Claims 10, 12-16, 26, 30 and 31

Claims 14-16 and 26 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Lense, and further in view of U.S. Patent Appl. Publ. No. 2002/0011393 A1, to Siemens (hereinafter “Siemens”). Claim 26 is also rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Muellner, and further in view of Siemens. In addition, claims 10, 12-13 and 30 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Lense, and further in view of Jones. Claim 30 is also rejected under 35 U.S.C. § 103(a) as

being unpatentable over Hino in view of Muellner, and further in view of Jones. Finally, claim 31 is rejected under 35 U.S.C. § 103(a) as being unpatentable over Hino in view of Lense, and further in view of Jones.

Similar to the discussion set forth hereinabove with respect to claim 3, supra §II.B.2, at 15, Applicants submit that claims 10, 12-16, 26, 30 and 31 are each patentably distinguishable from the prior art of record for at least those reasons as the independent claims from which they respectively depend. The variety of modifications and combinations proposed by the Examiner do not cure the fact that the prior art of record fails to render obvious any of the pending independent claims. Accordingly, the pending § 103(a) rejections of claims 10, 12-16, 26, 30 and 31 are believed to be improper, and should therefore be withdrawn.

III. CONCLUSION

In light of the foregoing reasoning and remarks, this submission is believed to be fully responsive to the Office Action, dated March 19, 2009. The remarks in support of the rejected claims are believed to place this application in condition for allowance, which action is herein respectfully requested. If the Examiner believes that a personal conference with Applicants' attorney will help expedite prosecution of the captioned application, the Examiner is reverently invited to contact the undersigned at his soonest convenience via the correspondence information presented below.

* * * * *

The Commissioner is hereby authorized to charge any necessary fees associated with this amendment to Nixon Peabody, LLP, Deposit Account No. 50-4181, Order No. 247171-000390USPT.

Respectfully submitted,
JOHN R. BLAKE et al.

Date: May 22, 2009

By: /William D. PEGG, Reg. # 42,988/
William D. Pegg
Reg. No. 42,988
Nixon Peabody LLP
161 N. Clark St., Suite 4800
Chicago, Illinois 60601
(312) 425-3900 – Telephone
(312) 425-3909 – Facsimile